



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,211	02/26/2002	Kazuaki Onishi	12010-0022	2588
22902	7590	05/19/2006	EXAMINER	
CLARK & BRODY 1090 VERMONT AVENUE, NW SUITE 250 WASHINGTON, DC 20005			REICHLE, KARIN M	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/082,211

Applicant(s)

ONISHI ET AL.

Examiner

Karin M. Reichle

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The substitute specification filed 2-24-06 has not been entered as such includes new matter. The substitute specification, e.g. page 13, first sentence of the marked up copy, sets forth an elastic member which extends midway between the end portions. While, e.g., the paragraph bridging pages 15-16 of the original specification disclosed that the elastic member extended along a zone of the distal end portion rather adjacent its proximal end portion, i.e. if one considers the terminal proximal edge as 0% and the terminal distal edge as 100%, then more than 50% but less than 75%, where is it originally disclosed that the member is part of the proximal end portion, i.e. 50% or midway? If Applicant traverses the rejection the portion of the specification which clearly supports such language should be set forth. See also the discussion in paragraph 8 *infra* and, e.g., page 6, lines 11-13 of the marked up specification. The marked up specification at, e.g., page 3, line 3 of the marked up copy and the abstract also did not show the changes made in compliance with 37 CFR 1.121 (It is noted that the abstract filed 11-9-04 was entered) and the marked up specification did not correct the portions referred to in paragraph 5 of the last Office Action.

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For example:

Drawings

3. The drawings were received on 2-24-06. These drawings are not approved. Since the drawings reflect changes set forth in the substitute specification and the latter has not been entered, the drawings are not approved.

4. The drawings are objected to because the cross-sectional lines, e.g., in Figure 1, line A-A, should be denoted by Roman or Arabic numerals. Note any changes made to such lines should also be made to any textual description of such lines, e.g., page 4, line 1-page 5, line 2 of the description. In Figure 1, the rightmost 5 does not denote the sheet which wraps core 6. The description and the Figures are inconsistent with regard to what the surfaces of the batt structures 4A and 6A are, which structures include the cores 4 and 6, respectively, as well as other sheets, and what the surfaces of the cores 4 and 6 are. For example, on page 6, lines 7-9, a body facing surface of structure 4A is described as 4c yet in Figure 1, the surface denoted 4c is the surface of the core 4 not the batt structure 4A. This also applies to what the structure 9 is, i.e. does it underlie the cuffs 7 or not, see, e.g. page 9, lines 3-4 and compare to Figure 1. The drawings and description should be carefully reviewed and amended, as necessary, to make the specification consistent throughout. Figure 1 does not show the elastic 10 between sheets 2 and 5 at the right side thereof nor along the distal end portion as set forth on page 7, lines 17 et seq. The latter objection also applies to Figures 2 and 4. As shown the elastic is not clearly along the distal end portion rather adjacent the proximal edge portion. This objection also applies to elastic 19 in Figures 5 and 6 and elastic 10 in Figure 10. In Figure 2, 13 should be 14. In Figure 2, 6a should be deleted. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing

Art Unit: 3761

sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Description

5. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: the abstract filed 11-9-04, lines 5 and 9, and page 2, lines 9-11 and page 21, first paragraph of the originally filed specification.

6. The disclosure is objected to because of the following informalities: The description and the Figures are inconsistent with each other and themselves with regard to what the surfaces of the batt structures 4A and 6A are, which structures include the cores 4 and 6, respectively, as

Art Unit: 3761

well as other sheets, and what the surfaces of the cores 4 and 6 are. For example on page 6, lines 7-9, a body facing surface of structure 4A is described as 4c yet in Figure 1, the surface denoted 4c is the surface of the core 4 not the batt structure 4A. See also page 6, lines 13-14 and the sentence bridging pages 10-11, i.e. what are the flaps 8 and what are the ends 4a of the batt structure 4A? This also applies to what the structure 9 is, i.e. does it underlie the cuffs 7 or not, see, e.g. page 9, lines 3-4 and compare to Figure 1. See also, e.g., page 9, first full paragraph and compare to the last paragraph on page 11. Note also the first two paragraphs on page 12. The drawings and description should be carefully reviewed and amended, as necessary, to make the specification consistent throughout. Page 12, first sentence is unclear, i.e. should the last “7a” be “7a”? On page 13, line 2, “4” should be --4A--. On page 15, line 7, “18 a2- The batt structure 18” should be --18a2. The batt structure 18A--. On page 15, line 12, “region” should be --regions--.

Appropriate correction is required.

Claim Objections

7. Claims 5-7 are objected to because of the following informalities: Claim 5, line 9 appears to be missing words or is grammatically incorrect. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

Art Unit: 3761

art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 5 now require an elastic member which is spaced from the free end of the distal end portion and toward the proximal end portion. It is noted that “toward” is defined as “in the direction of”. While, e.g., page 7, lines 17 et seq of the original specification disclosed that the elastic member extended along a zone of the distal end portion rather adjacent its proximal end portion, i.e. if one considers the terminal proximal edge as 0% and the terminal distal edge as 100%, then more than 50% but less than 75%, where is it originally disclosed that the member is spaced from the free end of the distal end portion and toward the proximal end portion, i.e. less than 100%? Applicant relies upon Figures 2-3 as original support for such language. However, Figures 2-3 do not provide support for the full scope of the claim language, e.g. less than 100% but greater than 75%. If Applicant traverses the rejection, the portion of the specification which clearly supports such language, i.e. the full scope thereof, should be set forth.

Claim Language Interpretation

9. Since Applicant has not specifically defined any of the claim terminology, such terminology will be given its usual, i.e. dictionary, meaning. Therefore, “substantially connected” is defined as substantially directly or indirectly connected. See also discussion in the preceding paragraph with respect to “toward”. Also see MPEP 2163.06, I. with respect treatment of subject matter considered new matter and rejections based on prior art, i.e. will be considered.

Double Patenting

10. The Terminal Disclaimer filed 2-24-06 has been approved.

Allowable Subject Matter

11. The claims distinguish over the prior art of record because the prior art references, alone or in any combination, do not teach an elastic member as set forth in the last two sections of claim 1 in combination with the other features claimed in claim 1. Note again the Claim Language Interpretation section supra.

Response to Arguments

12. Applicant's remarks filed 2-24-06 have been noted but are either deemed moot in that they have not been repeated or are deemed not persuasive for the reasons set forth supra.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3761

Any new grounds of rejection were necessitated by the amendments to claims 1 and 5.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

K.M. Reichle
Karin M. Reichle
Primary Examiner
Art Unit 3761

KMR
May 14, 2006